

CUSTOMER NO.34456

REMARKS

In the Office Action mailed June 6, 2005, claims 1-18 were rejected under 35 U.S.C. § 112, second paragraph and claims 1-5, 7-10, and 20 were rejected under 35 U.S.C. § 102(b). Claims 6 and 11-19 were rejected under 35 U.S.C. § 103(a). Reconsideration of the outstanding rejections in the present application is respectfully requested based on the following remarks.

1. A Worker Skilled in the Art Would Understand the Term Portable as Recited in the Claims When The Claims Are Read in Light of the Specification.

At page 2 of the Office Action, claims 1-18 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Office Action states:

it is unclear what the scope of being portable is in a portable audio player. The office interprets the word portable, as defined by the American Heritage Dictionary, to mean carried or moved with ease.

Office Action, p. 2.

Applicants respectfully traverse this rejection. However, the definition offered by the American Heritage Dictionary is consistent with the term as used within the specification. The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). Applicants respectfully submit that the disclosure provides multiple examples of portable audio players, as well as discussion of the limitations of conventional portable audio players, such that a worker skilled in the art would understand, in light of the specification, the term "portable audio player" as recited in independent claims 1, 10, and 11.

In the Background of the Invention, for example, the specification states:

Portable audio players afford users access to their preferred music and other audio selections anywhere at anyplace at anytime... Because portable audio files tend to be large in size (e.g., a typical MP3 digital music file is about three to five megabytes), portable audio players generally are equipped with a significant amount of storage space to accommodate a number of such audio files.

Application, p. 1, para. 2.

CUSTOMER NO.34456

Other features of conventional portable audio players are discussed in the Application at pages 1-2 and paragraph 3. Further, the application states:

A number of disadvantages and problems are associated with such portable audio players. For example, a data port of a portable audio player is generally only capable of one-way communication in the context of a pre-established protocol associated with the portable audio player. In addition, the peripheral devices that can be used with a portable audio player must possess certain performance criteria in order to function within the context of the pre-established protocols associated with the portable audio player. As such, peripheral devices are required to have componentry that is not necessarily commensurate with the intended application of the peripheral device... In short, the inflexibility of pre-established protocols associated with the portable audio player dictate the componentry of peripheral devices thereby reducing the autonomy of such peripheral devices.

Application, p. 2, para. 4.

Additionally, in the section entitled "Detailed Description of the Invention," there is additional discussion of a portable audio player. The application states:

A portable audio player allows a user to enjoy audio media such as music and audio books without being constrained to any one geographic location. The audio media can be in a number of formats including digital and analog and can be stored in storage 105. The audio media can be downloaded to storage 105 via a data port such as port 120 from a source such as a computer, a boom box, tape deck, compact disc player or an online digital audio media supplier...

Application, p. 6, para. 20.

Finally, examples of other similar portable electronic devices are provided. Specifically, the Application states:

although this disclosure focuses on portable audio players, other types of portable electronic devices can also incorporate the principles of the present invention, such as a personal digital assistant, a portable video player, or any portable electronic device that can act as a host and resource to the benefit of a peripheral device.

Application, p. 5, para. 18.

A personal digital assistant (or PDA), for example, is typically a hand-held type device that can be readily and easily transported. Thus, the application provides sufficient illustration and discussion of the term portable as recited in claims 1, 10 and 11, that a worker skilled in the

CUSTOMER NO.34456

art would understand what is being claimed when the claims are read in light of the specification. Therefore, the rejection of claims 1-18 is improper and should be withdrawn. Reconsideration and notice to that effect is respectfully requested.

2. Chang Fails to Disclose or Suggest All the Elements of Claims 1-5 and 7-10.

Claims 1-5 and 7-10 were rejected under 35 U.S.C. §102(b) as being anticipated by Chang et al., U.S. Pat. No. 5,991,885 ("Chang '885"). This rejection is respectfully traversed.

Regarding claim 1, the Office Action states that "Chang teaches these features in a network of computers" and that it is "well known in the art that a computer can function as an audio player." See Office Action, p. 3, para. 6. Regarding claim 10, the Office Action states that "Chang teaches a communication port, a transceiver, and a processor as claimed (Col. 13, lines 38-53)" and suggests that "[i]t is inherent that a processor in a system... adapts to bit rate associated with the peripheral device..." Applicants disagree. In contrast to claims 1 and 10, Chang '885 discloses a network system with a network hub that determines the operational protocol of a coupled device and that communicates with the coupled device via that protocol. See, for example, Chang, FIGS. 2 and 3, Abstract, Col. 3, lines 38-60 and Col. 5, lines 12-28.

Claim 1 recites:

A portable audio player comprising:
a *communication port* for facilitating bi-directional communication between the portable audio player and a peripheral device; and
a processor operatively coupled to the communication port, the processor adapted to determine a bit rate associated with communications from the peripheral device.

(Emphasis added).

Claim 10 recites:

A portable audio player comprising:
a *communication port* for facilitating bi-directional communication between the portable audio player and a peripheral device;
a *transceiver operatively coupled to the communication port*, the transceiver for transmitting data to the peripheral device and for receiving data from the peripheral device; and
a processor for adapting the transceiver to a bit rate associated with the peripheral device.

(Emphasis Added).

CUSTOMER NO.34456

Chang '885 fails to disclose or suggest a portable audio player having a communication port and a processor adapted to determine a bit rate, as recited in claim 1.

Chang '885 discloses a network hub that determines a network protocol. *See* Col. 6, lines 4-11. There is no suggestion in Chang '885 that such a network hub is portable. Moreover, Chang '885 teaches a network hub that determines an operational protocol, such as infrared, Ethernet 10Base-T, 100Base-TX, or Token Ring (*See* Col. 5, lines 22-27, Col. 13, lines 39-41). Such protocols constitute operational protocols, rather than bit rates, as recited in claims 1 and 10. Finally, Chang '885 fails to disclose or suggest a portable audio player having a processor coupled to a communications port, wherein the processor is adapted to determine a bit rate associated with communications from a peripheral device, as recited in claim 1. Similarly, Chang '885 fails to disclose or suggest a processor for adapting a transceiver to a bit rate associated with a peripheral device, as recited in claim 10. Thus, Chang '885 fails to suggest or disclose all the elements of claims 1 and 10. Therefore, the rejections of claims 1 and 10 are improper and should be withdrawn. Reconsideration and notice to that effect is respectfully requested.

Claims 2-5 and 7-9 depend from independent claim 1. As previously discussed, Chang '885 does not disclose or suggest all the elements of claim 1. Therefore, Chang '885 fails to disclose or suggest all the elements of claims 2-5 and 7-9, at least based on their dependency from claim 1. Therefore, the rejections of claims 2-5 and 7-9 are improper and should be withdrawn. Reconsideration and notice to that effect is respectfully requested.

3. Goldstein Fails to Disclose or Suggest All the Elements of Claim 20.

Claim 20 was rejected under 35 U.S.C. §102(b) as being anticipated by Goldstein, U.S. Pat. No. 5,317,594 ("Goldstein '594"). This rejection is respectfully traversed.

At pages 4-5, the Office Action states that "Goldstein teaches a method for establishing a bi-directional communication link" with the features of claim 20, citing *Goldstein*, Col. 2, lines 15-27. However, the cited paragraphs of Goldstein '594 reference a technique for establishing a communication link between modems, using "one or more tones, a spectrum of frequencies for probing, etc." *See Goldstein*, Col. 2, lines 19-24. Moreover, the cited paragraphs of Goldstein

CUSTOMER NO.34456

'594 refer to a technique that is specific to a V.fast modem. The Goldstein '594 application discloses:

With the provided arrangement for determining the presence of a V.fast modem, it will be appreciated that if the call mode modem is not a V.fast modem, but rather is a V.32 or V.32bis type modem, when the answer mode V.fast type modem sends the predetermined signal, the call mode modem will ignore that signal and will wait for the S signal. Thus, if within the undefined 8192 baud period following the sixteen baud silence period which follows the AC/CA/AC signal sequence, the answer mode modem does not receive the confirming signal from the call mode modem, it will determine that the call mode modem is not a V.fast modem but is a V.32 or V.32bis type modem and will continue with the V.32/V.32bis handshake according to known standards. Thus, the V.fast modem will be compatible with the V.32/V.32bis standards. On the other hand, if the call mode modem is a V.fast modem but the answer mode modem is a V.32 or V.32bis modem, the predetermined signal will never be sent from the answer mode modem to the call mode modem. Thus, the call mode modem will continue as a V.32/V.32bis type modem and will continue the V.32/V.32bis handshake according to known standards.

Goldstein '594, Col. 2, lines 28-51.

Goldstein '594 fails to teach or suggest transmission of a known character from the peripheral device to the host device. Moreover, Goldstein '594 fails to teach or suggest confirming a target bit rate, as recited in claim 20. Further, one or more tones or a spectrum of frequencies does not equate to a known character or a reply character as recited in claim 20. The modem device disclosed in Goldstein '594 confirms a modem protocol, not a bit rate as recited in claim 20. Thus, Goldstein '594 fails to disclose or suggest all of the elements of claim 20. Therefore, the rejection of claim 20 is improper and should be withdrawn. Reconsideration and notice to that effect is respectfully requested.

4. Chang and Key Fail to Disclose or Suggest All the Elements of claims 6 and 11-17.

At page 5 of the Office Action, claims 6 and 11-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Chang '885 in view of Key et al., U.S. Pat. No. 5,008,902 ("Key '902"). Applicants respectfully traverse this rejection.

CUSTOMER NO.34456

Claim 6 depends from independent claim 1. As previously discussed, Chang '885 fails to disclose or suggest all the elements of independent claim 1. The Office Action states:

[Chang '885] fails to teach the adjusting of a receiving bit rate. Key teaches the automatic detection of baud rates using the transmission of known characters in various peripherals (Col. 1, lines 10-14). It would have been obvious for one of ordinary skill in the art to combine the teachings of Chang and Key for the purpose of automatically determining the baud rate, or the rate of transmission, of a peripheral device.

Office Action, p. 5, para. 19.

First, the combination of the network hub of Chang '885 with the automatic detection of baud rates of Key '902 does not result in a portable audio player as recited in claim 1. Second, there is no teaching in either reference to make the asserted combination. The network hub of Chang '885 performs protocol detection. There is no suggestion in Chang '885 of a need to perform bit rate adjustment. Finally, with respect to claim 6, Chang '885 uses a network hub to detect a protocol, and Key '902 uses accumulated bits to detect a baud rate. Neither Chang '885 nor Key '902 disclose or suggest "adjusting a receiving bit rate ... until a known character ... is recognized" as recited in claim 6. Thus, the combination of Chang '885 and Key '902 fails to disclose or suggest all of the elements of claim 6. Therefore, the rejection of claim 6 is improper and should be withdrawn. Reconsideration and notice to that effect is respectfully requested.

Independent claim 11 recites a method for establishing a bi-directional communication link between a portable audio player and a peripheral device. The method comprises transmitting known data from the peripheral device to the portable audio player at a peripheral device bit rate, determining the peripheral device bit rate in response to the portable audio player recognizing the known data, and confirming a valid communication link at the peripheral device bit rate. As previously discussed, Chang '885 is directed to a network hub, not a portable audio device. Additionally, as discussed above with respect to claim 6, the asserted combination of Chang '885 and Key '902 is not suggested by the references, nor does the asserted combination teach a portable audio player. Combining the network hub of Chang '885 with the automatic baud rate detection of Key '902 does not disclose or suggest all the elements of claim 11. Thus, the rejection of claim 11 is improper and should be withdrawn. Reconsideration and notice to that effect is respectfully requested.

CUSTOMER NO.34456

With this amendment, claim 12 is canceled without prejudice. Claims 13-17 depend from independent claim 11. Thus, at least based on their dependency from claim 11, Chang '885 and Key '902 fails to disclose or suggest all of the elements of claims 13-17. Therefore, the rejection of claims 13-17 is improper and should be withdrawn. Reconsideration and notice to that effect is respectfully requested.

5. Chang, Key and Goldstein Fail to Disclose or Suggest All the Elements of Claim 18.

Claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Chang '885, Key '902 and Goldstein '594. This rejection is hereby respectfully traversed.

Claim 18 depends from claim 11 and recites the steps of "transmitting a reply character..." and "confirming a valid communication link" responsive to the peripheral recognizing the reply character. As discussed above with respect to claim 11, neither Chang '885 nor Key '902 disclose or suggest all of the elements of independent claim 11, and therefore fail to disclose or suggest all of the elements of claim 18. The Office Action states that the combination of Chang '885 and Key '902 do not teach a validation step.

Goldstein teaches a method of identifying older, slower transmission rates with newer modems, and this method includes a confirmation step. It would have been obvious for one of ordinary skill in the art to combine the teachings of Chang, Key, and Goldstein for the purpose of providing backward compatibility with transmission standards.

Office Action, p. 7, para. 28.

Moreover, there is no motivation to combine a modem with a network hub. Finally, none of the references suggest or disclose "transmitting a reply character" as recited in claim 18. As previously discussed, Goldstein uses "one or more tones, a spectrum of frequencies for probing, etc." (*See Goldstein*, Col. 2, lines 19-24) to determine a modem protocol, such as V.Fast or V.32, for example. *See Goldstein*, Col. 2, lines 15-27. Tones or a spectrum of frequencies do not equate to "a reply character" as recited in claim 18. Thus, the asserted combination fails to disclose or suggest all the elements of claim 18, and the rejection should be withdrawn. Reconsideration and notice to that effect is respectfully requested.

CUSTOMER NO.34456

6. Key and Goldstein Fail to Disclose or Suggest All the Elements of Claim 19.

With this response, claim 19 is amended to correct a typographical error detected by the Applicants. Specifically, the term "and" was incorrectly placed within the claim.

With regard to the Office Action, claim 19 was rejected under 35 U.S.C. §102(b) as being anticipated by the combination of Key '902 and Goldstein '594. Applicants respectfully submit that the rejection under §102(b) is improper. A rejection under §102 over multiple references has been held to be proper when the extra references are cited 1) to prove that the primary reference contains an enabled disclosure, 2) to explain the meaning of a term used in the primary reference, or 3) to show that a characteristic not disclosed in the reference is inherent. *See* M.P.E.P. §2131.01. In the Office Action, Goldstein '594 is cited because Key does not teach the step of transmitting a reply character. Therefore, the rejection of claim 19 under §102(b) over multiple references is improper and should be withdrawn.

In addition to the improper basis for the rejection, Applicants note that the asserted combination of Key '902 and Goldstein '594 fails to disclose or suggest all of the elements of claim 19. Key '902 teaches sampling an incoming serial data stream at twice the highest baud rate, storing the samples, and comparing odd numbered samples to known autobaud characters. *See* Key, Col. 2, lines 5-15. Key '902 fails to disclose receiving a known character, and adjusting a first bit rate until the known character is recognized as recited in claim 19. The technique described in Goldstein '594 fails to overcome the deficiency of Key '902. Specifically, the one or more tones or the spectrum of frequencies of Goldstein '594 does not equate to a known character. Moreover, Goldstein '594 discloses adjusting a modem protocol from V.Fast to V.32, for example, rather than adjusting a bit rate as recited in claim 19. There is no suggestion in either reference that the protocol adjustment technique of Goldstein '594 could be used to perform bit rate adjustment as recited in claim 19. Thus, the asserted combination does not disclose or suggest all of the elements of claim 19. Moreover, the asserted motivation for making the combination is not supported by the disclosures of Key '902 or Goldstein '594. Rather, the asserted motivation constitutes a hindsight reconstruction based on the

CUSTOMER NO.34456

disclosure of the present application. Therefore, the rejection of claim 19 over Key '902 and Goldstein '594 is improper and should be withdrawn. Reconsideration and notice to that effect is respectfully requested.

7. New Claim 21.

New claim 21 recites:

an audio port adapted to output an audio signal related to an audio file while the storage unit is storing non-audio data received from the peripheral device via the communication port.

None of the cited references teach, suggest or disclose a portable audio device having an audio port adapted to output an audio signal related to an file while the storage unit is storing non-audio data received from the peripheral device via the communication port. Thus, Claim 21 is allowable over the cited references.

CUSTOMER NO.34456

CONCLUSION

Applicants respectfully submit that the present application is in condition for allowance. Accordingly, the Examiner is requested to issue a Notice of Allowance for all pending claims. If, for any reason, the Office is unable to allow the Application on the next Office Action, and believes a telephone interview would be helpful, the Examiner is respectfully requested to contact the undersigned attorney or agent.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

9/6/05

Date



Adam D. Sheehan; Reg. No. 42,146
Attorney for Applicant(s)
TOLER, LARSON & ABEL, L.L.P.
5000 Plaza On The Lake, Suite 265
Austin, Texas 78746
(512) 327-5515 (phone)
(512) 327-5452 (fax)